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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ITT Industries, Inc.

Serial No. 78456701

Robert P. Seitter of RatnerPrestia for ITT Industries, Inc.

Ellen F. Burns, Trademark Examining Attorney, Law Office
116 (M.L. Hershkowitz, Managing Attorney).

Before Hohein, Drost and Kuhlke, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 26, 2004, ITT Industries, Inc. (applicant)
applied to register the mark K-PATH and design shown below
on the Principal Register for goods identified as "computer
software for controlling single and multiple vehicles using
information from the GPS constellation for navigation" in
Class 9. Serial No. 78456701.



The application contains an allegation of a date of first use anywhere and in interstate commerce of June 2004.

The examining attorney has refused to register applicant's mark because the mark "on the specimen is clearly unitary; and because it materially differs from the drawing mark." Brief at 14. The mark on the specimen is shown as follows:



Applicant attached an enlarged version of the specimen with its brief:



The examining attorney argues (Brief at unnumbered p.4):

The specimen mark shows a diamond-shape created by a solid shaded border surrounding an interior topographical map design, with the wording ITT INDUSTRIES, AES DIVISION, SEMI-AUTONOMOUS, and CONTROL SYSTEM placed inside the shaded border around the map. The wording K-PATH and a Y-shaped arrow are superimposed on the map inside the border. The drawing mark, on the other hand, consists of only two of those elements: The diamond-shape as depicted by a blank, double-line border and the K-PATH/arrow element on the interior.

In other words, the applicant has not merely lifted the K-PATH/arrow portion of the design from the specimen mark for registration; rather, the applicant has created a new mark by depicting the word-filled, shaded border as a blank, double-line carrier, thereby retaining a diamond shape but removing the map design from the interior, and removing the shading and wording from the border. In doing so, the applicant leaves out a fully integrated design element (map) and the highlighted additional wording, both of which enhance and relate to the K-PATH/arrow portion of the design.

In response, applicant maintains (Reply Brief at 4) that:

[A]pplicant has never disputed the nature of the background but rather has repeatedly made the point that as a practical matter the topographical map design is little more than an amorphous pattern of colors in the background. No matter how identifiable the topographical map may appear in a grayscale or as a color image, it becomes far less identifiable in 2-color black and white... The applicant sought to register the mark in true black and white having only 2-color (black and white) color depth.

Regarding the omitted wording, applicant argues that the words "Semi-Autonomous Control System" are generic and the words "ITT Industries" and "AES Division" are "analogous to house marks." Brief at 10. Applicant concludes that "the

drawing as sought to be registered would be easily recognizable to consumers as the mark encountered in the marketplace, as depicted in the specimen." Brief at 13.

Applicant now seeks review of the examining attorney's final refusal to register applicant's mark.

USPTO rules (37 CFR § 2.51(b)) require:

In an application under section 1(b) of the Act, the drawing of the mark must be a substantially exact representation of the mark as intended to be used on or in connection with the goods and/or services specified in the application, and once an amendment to allege use under § 2.76 or a statement of use under § 2.88 has been filed, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.

The TMEP § 807.12(d) (4th ed. rev. April 2005) sets out the standard for determining whether an applicant is permitted to register less than the entire mark shown on the specimen.

In an application under § 1 of the Trademark Act, the mark on the drawing must be a complete mark, as evidenced by the specimen. When the representation on a drawing does not constitute a complete mark, it is sometimes referred to as "mutilation." This term indicates that essential and integral subject matter is missing from the drawing. An incomplete mark may not be registered.

However, in a § 1 application, an applicant has some latitude in selecting the mark it wants to register. The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. An applicant may apply to register any element of a

composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen.

The determinative factor is whether or not the subject matter in question makes a separate and distinct commercial impression apart from the other element(s).

The question of whether a mark is a mutilation "boils down to a judgment as to whether that designation for which registration is sought comprises a separate and distinct 'trademark' in and of itself." Institut National des Appellations D'Origine v. Vintners International Co., 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992).

The examining attorney maintains that the mark is a mutilation because it does not contain the topographical map and the wording in the double diamond. Initially, we note that the examining attorney also appears to object to the fact that applicant has shown "the shaded border as a blank, double-line carrier." Brief at unnumbered p.4. However, applicant has submitted a black-and-white drawing and this would simply indicate the border in applicant's specimen. "Applicants who seek to register a mark that includes a two or three-dimensional design; color; and/or words, letters, or numbers or the combination thereof in a particular font style or size must submit a special form drawing. The drawing must show the mark in black on a

white background, unless the mark includes color." 37 CFR § 2.52(b). While the USPTO now accepts drawings with gray tones, applicants are not prohibited from depicting their marks as a black-and-white drawing because there are gray tones on the specimen. TMEP § 807.07(e) (4th ed. rev. April 2005) ("Unless an applicant claims the color gray, color will not be considered to be a feature of the mark and the drawing will be processed as a black and white drawing").

Regarding applicant's map, it is difficult to recognize even in an enlarged version of the specimen. The map resembles random lines and does not create much of a visual impression. Sheller-Globe Corp. v. Scott Paper Co., 204 USPQ 329, 337 (TTAB 1979):

It is apparent that the commercial impression projected by applicant's mark is generated by the letters "SG" in conjunction with the grid design and the border without any contribution by the lines (which are mathematical curves) that depict technical characteristics of the products to purchasers, who constitute a relatively narrowly defined class of technically informed persons. To require applicant to seek registration for each version of the "SG" and design mark containing a variation of the curve would unduly proliferate applications at unnecessary cost to applicant and to the Patent and Trademark Office with no benefit to the public.

In contrast, in In re Library Restaurant Inc., the proposed mark was held not to create a separate commercial impression from the material on the specimen shown below. 194 USPQ 446 (TTAB 1977).

Drawing



Specimen



In applicant's case, the absence of some of the design features on the specimen would not result in applicant registering less than its entire mark. Unlike the Library Restaurant case, there is nothing missing from the mark and it appears as a separate and distinct mark.

Next, we look at the words that the examining attorney points out are missing from the drawing but present on the specimen: "ITT Industries," "AES Division," "SEMI-AUTONOMOUS CONTROL SYSTEM." We agree with applicant that "ITT Industries" and "AES Division" are equivalent to a house mark or trade name. The omission of these names does not normally result in a mutilation of the mark. In re Servel, Inc., 181 F.2d 192, 85 USPQ 257, 260 (CCPA 1950) ("The courts in a proper case may recognize the right to registration of one part of an owner's mark consisting of

two parts." SERVEL functions as a mark apart from the term INKLINGS); Textron Inc. v. Cardinal Engineering Corp., 164 USPQ 397, 399 (TTAB 1969) ("While the record does show that Textron's principal or house mark 'HOMELITE' appears on its chain saws as well as in all of its advertising literature, there is no statutory limitation on the number of trademarks that one may use on or in connection with a particular product to indicate origin"); and In re Emco, Inc., 158 USPQ 622, 623 (TTAB 1968) ("It is concluded that the law and the record support applicant's position that 'RESPONSER' is registrable without addition of the surname 'MEYER'"). Indeed, several cases have held that an applicant's use of its corporate name or house mark that was physically connected to another trademark did not create a unitary mark. See, e.g., In re Berg Electronics, Inc., 163 USPQ 487 (TTAB 1969) (GRIPLET creates a separate commercial impression despite overlapping with house mark BERG) and In re Dempster Brothers, Inc., 132 USPQ 300 (TTAB 1961) (DUMPMASER shown on specimen as:

D E M P S T E
U M P M A S T E **R**

separately registrable). In addition, the terms "ITT Industries" and "AES division" are displayed in much

smaller type than the term K-PATH and they are shown against a less distinctive background. Visually, the terms are much less significant. Therefore, the words "ITT Industries" and "AES division" do not create the impression that they are part of a unitary mark with the material in applicant's drawing.

Next, we look at the words "SEMI-AUTONOMOUS CONTROL SYSTEM." Applicant has consistently maintained that the words are generic. See Response dated March 3, 2005, p.2; Request for Reconsideration, p.14; and Brief, p.10. According to the examining attorney, the "border wording, meanwhile, directly indicates the source of the goods (ITT Industries AES Division, ITT and AES both being arbitrary terms) and the nature of the goods (semi-autonomous control systems)." Denial of Request for Reconsideration, p.2. Earlier, the examining attorney disagreed "about the lack of visual impact, particularly of 'semi-autonomous control system,' which extends continuously over 50% of the mark outline ...[and in] addition may be descriptive of the goods." Final Office Action, p.2. The examining attorney also argues that applicant is not attempting to remove a

stock number or "a common, one-word generic term for the goods." Brief at unnumbered p.9.¹

Regarding the words "SEMI-AUTONOMOUS CONTROL SYSTEM," we note that they are displayed in much smaller type and they are physically separate from the term K-PATH. They are much less visible and they are easily overlooked. Furthermore, they appear as merely informational material on the specimens and, as the examining attorney notes, they provide insight on "the nature of the goods." Applicant's specimen refers to a "Remote Control Program" for a dune buggy as well as a "Remote Control System" and a "Semi Autonomous Control System." This wording would simply be viewed as information about applicant's "control systems." Even wording that appears in much closer proximity to the other wording on a specimen has not been held to be unitary. In re Barry Wright Corp., 155 USPQ 671, 672 (TTAB 1967) ("[I]t is clear that the notation '8-48' stands out as a distinguishable element separate and apart from the statement 'ANOTHER 8-48 FROM MATHATRONICS'"); In re Raychem Corp., 12 USPQ2d 1399, 1400 (TTAB 1989) (Board held that the "fact that hyphens connect both the part number and the generic term in 'TR06AI-TINEL-LOCK-RING' to the mark does

¹ The examining attorney also raises for the first time the lack of evidence of genericness.

not, under the circumstances presented by this case, create a unitary expression such that 'TINEL-LOCK' has no significance by itself as a trademark"). Furthermore, mere proximity "does not endow the whole with a single, integrated, and distinct commercial impression." Dena Corp. v. Belvedere International Inc., 960 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). In the mark shown below, "EUROPEAN FORMULA in large type appears to stand out and convey a meaning wholly unrelated to the circular design. Viewing the mark in its entirety, as it must, this court determines that Belvedere does not seek registration of a unitary mark." Id.



Therefore, the mere presence of other wording on a specimen in close association with the identified mark does not necessarily create a unitary impression. In In re Tekelec-Airtronic, 188 USPQ 694, 695 (TTAB 1975), the board held that:

It is our opinion, notwithstanding that the notations "TEKELEC" and "AIRTRONIC" are separated by the letters "TA" and design, that they are the only literal portions of the material appearing on the label specimens; they constitute applicant's corporate name; they are displayed in the same type of lettering and presented against the same background design so as to engender a single unitary and separable commercial impression; and, as a consequence, "TEKELEC AIRTRONIC" would be recognized and utilized in and of itself as one of applicant's trademarks serving to identify and distinguish applicant's goods in commerce.

The examining attorney refers to In re Boyd Coffee Co., 25 USPQ2d 2052 (TTAB 1993) as "a directly analogous case." Brief at unnumbered p.7. However, we do not find the facts of that case to be on point. In that case, applicant sought to register the following mark supported by the specimen use shown below:

Drawing



Specimen



The board held "the cup and saucer and the sunshine design are interrelated elements" and the board agreed that it was reasonable for the examining attorney to conclude that "the sun's rays appear to be emanating from the cup." 25 USPQ2d at 2053. In the instant case, there is no such interrelationship between the omitted elements and the mark

that applicant seeks to register. The topographical map and the wording are insignificant elements. The board in Boyd Coffee added that "applicant would have a stronger case for registrability of the cup and saucer design were it to be displayed on applicant's goods against a sunburst design in a different color or shade, so that the cup and saucer design stood out from the rest of the design." Id. In the present case, the arrow and the term K-PATH are in darker print and more noticeable than the omitted elements and, therefore, they do stand out from the other material on the specimen.

We conclude that the mark sought to be registered creates a separate and distinct commercial impression from the other material on the specimen. The mark stands out on the specimen and the other material is insignificant as well as hard to notice. Therefore, applicant's mark is not a mutilation of a unitary mark, and it is a substantially exact representation of the mark shown on the specimen.

Decision: The refusal to register is reversed.